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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,048	02/27/2004	David S. Benco	35-29	9557

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Docket Administrator (Room 3J-219)
Lucent Technologies Inc.
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EXAMINER

TRAN, QUOC DUC

ART UNIT PAPER NUMBER

2643

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,048	Applicant(s) BENCO ET AL.	
	Examiner Quoc D. Tran	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

Claim Rejections - 35 USC § 112

1. Claims 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 19 and 20 claimed the reverse sequence of the originally presented claims 1 and 11 that involved consulting the called party list prior to consulting the calling party list. It is acknowledged that contents of the claims 19 and 20 are disclosed. However, the inventive steps of the claims 19-20 were not disclosed in the specification.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6-12 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (2003/0114139).

Consider claim 1, Brown et al teach a method comprising the steps of: connecting a call between a calling party and called party (see ¶ 0139-0140); consulting a calling party billing list (i.e., profile 51 and 53) to determining whether the calling party has authorized alternative billing

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treatment for the call (see ¶ 0115-0117); and if the calling party has authorized alternative billing treatment, generating a billing record to bill the calling party according to the alternative billing treatment (see ¶ 0098); if the calling party has not authorized alternative billing treatment: consulting a called party billing list (i.e., profile 54 and 56) to determining whether the called party has authorized alternative billing treatment for the call (see ¶ 0123-0124); and if the called party has authorized alternative billing treatment, generating a billing record to bill the called party according to the alternative billing treatment (see ¶ 0125-0127).

Consider claim 2, Brown et al teach the method further comprising, if the calling party has authorized alternative billing treatment; sending a message to one or both of the calling party and called party indicating that the calling party is being billed for the call according to the alternative billing treatment (see ¶ 0099).

Consider claim 3, Brown et al teach wherein the call comprises a wireless call having a plurality of call legs, the alternative billing treatment comprising an authorization to charge one or more of airtime minutes and monetary charges for each of the call legs to the calling party (see ¶ 0082,0098).

Consider claim 6, Brown et al teach the method further comprising, if the called party has authorized alternative billing treatment: sending a message to one or both of the calling party and called party indicating that the called party is being billed for the call according to the alternative billing treatment (see ¶ 0099).

Consider claim 7, Brown et al did not suggest wherein the call comprises a wireless call having a plurality of call legs, the alternative billing treatment comprising an authorization to

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charge one or more of airtime minutes and monetary charges for each of the call legs to the called party (see ¶ 0082, 0135).

Consider claim 8, Brown et al teach wherein the call comprises a wireline call (see ¶ 0082, 0084), the alternative billing treatment comprising an authorization to bill monetary charges associated with the wireline call to the called party (see ¶ 0125).

Consider claim 9, Brown et al teach wherein the step of consulting the called party billing list comprises: identifying a directory number associated with the calling party, defining a calling party directory number; determining if the calling party directory number is present in the called party billing list, a presence of the calling party directory number in the called party billing list indicating that the called party has authorized alternative billing treatment (see ¶ 0134, 0135).

Consider claim 10, Brown et al teach the method further comprising, if the calling party has not authorized alternative billing treatment, generating a billing record for the call according to customary practice (see ¶ 0125).

Consider claim 11, Brown et al teach a method comprising the steps of: receiving billing information associated with a call between a calling party and called party (see ¶ 0125, 0139-0140); consulting a calling party billing list to determining whether the calling party has authorized alternative billing treatment for the call (see ¶ 0115-0117); and if the calling party has authorized alternative billing treatment, generating a billing record to bill the calling party according to the alternative billing treatment (see ¶ 0098); if the calling party has not authorized alternative billing treatment: consulting a called party billing list to determining whether the called party has authorized alternative billing treatment for the call (see ¶ 0123-0124); and if the

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called party has authorized alternative billing treatment, generating a billing record to bill the called party according to the alternative billing treatment (see ¶ 0125-0127).

Consider claim 12, Brown et al teach wherein the call comprises a wireless call having a plurality of call legs, the alternative billing treatment comprising an authorization to charge one or more of airtime minutes and monetary charges for each of the call legs to the calling party (see ¶ 0082,0098).

Consider claim 15, Brown et al did not suggest wherein the call comprises a wireless call having a plurality of call legs, the alternative billing treatment comprising an authorization to charge one or more of airtime minutes and monetary charges for each of the call legs to the called party see ¶ 0082, 0135).

Consider claim 16, Brown et al teach wherein the call comprises a wireline call (see ¶ 0082, 0084), the alternative billing treatment comprising an authorization to bill monetary charges associated with the wireline call to the called party (see ¶ 0125).

Consider claim 17, Brown et al teach wherein the step of consulting the called party billing list comprises: identifying a directory number associated with the calling party, defining a calling party directory number; determining if the calling party directory number is present in the called party billing list, a presence of the calling party directory number in the called party billing list indicating that the called party has authorized alternative billing treatment (see ¶ 0134, 0135).

Consider claim 18, Brown et al teach the method further comprising, if the calling party has not authorized alternative billing treatment, generating a billing record for the call according to customary practice (see ¶ 0125).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (2003/0114139) in view of Rosinski et al (5,381,467).

Consider claims 4 and 13, Brown et al suggest wherein the step of consulting the calling party billing list comprises; identifying the called party (i.e., recipients); determining if the called party is present in the calling party billing list, a presence of the called party in the calling party billing list indicating that the calling party has authorized alternative billing treatment (see ¶ 0126). Brown et al did not suggest identifying the directory number associated with the called party in the billing list to indicating that the calling party has authorized alternative billing treatment. However, Rosinski et al suggested such (col. 7 lines 7-18). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to incorporate the teaching of Rosinski et al into view of Brown et al in order to determine billing preference for a particular call.

Response to Arguments

6. Applicant's arguments filed 11/29/2005 have been fully considered but they are not persuasive.

In response to applicant argument on pages 7-8 regarding rejection of claims 19 and 20 under 35 U.S.C. 112, first paragraph is improper. Applicant alleged that since page 2 lines 21-23

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of applicant's specification and abstract recite, "a network device consults tailored billing list(s) of customer(s)" and "Methods are disclosed for billing customer calls according to predefined billing lists", it is well understood to one skilled in the art that the calling party and the called party billing lists may be consulted in any order. Accordingly, the examiner respectfully disagrees with applicant arguments. Applicant specification directed to only two (2) embodiments. The first embodiment is directed to consulting the billing lists during the call and the second embodiment is directed to consulting the billing lists after completing the call. In both embodiments, it clearly shown that the **billing lists are consulted** by first **consulting the calling party billing list** to determine if the calling party has authorized alternative billing treatment. If not, then the **called party billing is consulted**. Thus, there is no evident whatsoever that there exist a third embodiment nor suggestion that the billing lists are consulted in any order. Therefore, one skilled in the art not recognized that the billing list may be consulted in any order other than what disclosed in applicant specification.

Response to applicant argument that Brown disclosure is different applicant claimed subject matter and that calling party and called party profiles are consulted for the purpose of initiating a billed transaction that will prospectively billed to the called party and that the ***transaction is never billed to the calling party based on the calling party profile***. Accordingly, the examiner respectfully disagrees with applicant argument. Brown et al clearly disclose of **billing the caller** based on the caller profile that includes billing preferences (see ¶ 0061 and 0098).

Regarding applicant argument with respect to claims 3 and 12 that Brown does not teach or suggest of charging both legs of a wireless call to the calling party. Accordingly, the examiner

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respectfully disagrees with applicant argument. As discussed above, Brown et al enable the transaction (i.e., long distance service call) to be billed to the caller or the called party. Thus, if one or both party conducts the transaction via a wireless device, airtime charges for conducting the transaction must be billed. Therefore, both side are billed to either the calling party or the called party.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any response to this action should be mailed to:

Mail Stop ____ (explanation, e.g., Amendment or After-final, etc.)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Facsimile responses should be faxed to:
(571) 273-8300

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Hand-delivered responses should be brought to:


Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Quoc Tran** whose telephone number is **(571) 272-7511**. The examiner can normally be reached on M, T, TH and SATURDAY from 8:00 to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Curtis Kuntz**, can be reached on **(571) 272-7499**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600** whose telephone number is **(571) 272-2600**.

QUOCTRAN
PRIMARY EXAMINER


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February 5, 2006